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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 02/25/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/507,484

Applicant(s)

BECKER ET AL.

Examiner

Matthew J. Ludwig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11, 12, 14-20, 22, 24, 25 and 27 is/are rejected.
- 7) ☒ Claim(s) 8, 10, 13, 21, 23 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Application filed on 2/10/03.
2. Claims 1-27 are pending in the case. Claims 1, 14, 27 are independent claims.
3. The rejections of claims 1-7, 9-20, and 22-27 under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Cohen have been withdrawn as necessitated by Applicant's argument. The rejections of claims 8 and 21 under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Cohen and further in view of Fogg have been withdrawn as necessitated by Applicant's argument.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-27 provisionally rejected under the judicially created doctrine of double patenting over claims 1-24 of copending Application No. 09507485. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common

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subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite substantially the same subject matter differing mainly in scope and utilization of the phrase "enhanced presentation capabilities", however, the enhanced presentation capabilities would have been obvious to one of ordinary skill in the art at the time the invention was made because similar characteristics utilized in the underlying data obtained from previous selections of the hyperlink would have provided a proficient means of enhancing the users downloaded web page appropriate to the hyperlink.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7, 9, 11, 12, 14-20, 22, 24, 25, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Netscape® Communicator 4.08 (screenshots and help manual), © 1994-1998 herein after Netscape.

In reference to independent claim 1, 4, and 27, Netscape teaches:

Responsive to a computer receiving a user selection of a hyperlink to download data, it downloads the underlying data represented by the hyperlink, namely the page (compare to

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“responsive to receiving user instructions to download a web page, commencing downloading of the web page”). See Netscape, page 39, “Using Caches”, paragraph 1.

Netscape discloses selecting a link, which is user input that includes the direction of a cursor proximate a hyperlink. Upon selection of the link, Netscape teaches consulting the database to determine whether or not one or more users previously selected said link (compare to “if one or more users in the predefined group have previously selected the hyperlink, consulting a database...”). See Netscape, page 39, “Using Caches”, paragraph 3. Because the above-referenced version of Netscape runs under WindowsNT (screen shot 4), which was common at the time of the invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the predefined access group consisting of one or more users as taught by WindowsNT, because it would have given the Cache a proficient selection means for delivering specific content to a target user. Netscape further discloses representing characteristics of the underlying data, namely the web page it describes, obtained previously. See Netscape, page 39, “Using Caches”, paragraph 3.

The reference does not explicitly disclose the technique of referencing the identified characteristics against a presentation table to derive enhanced presentation attributes appropriate to the hyperlink; however, Burg teaches the modification of the visual representation of a cursor based on link areas within a document when a cursor is placed over specified link area. The ***enhanced presentation attributes*** (as presently claimed) do not preclude the Examiner from utilizing the cursor/link methods of Burg to provide of a reasonable suggestion of enhanced presentation attributes appropriate to a hyperlink. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Netscape and Burg before him at the time the

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invention was made, to modify the document retrieval methods taught by Netscape to include the enhanced presentation attributes appropriate to a hyperlink of Burg, because it would have provided a browser application with a proficient means for modifying the visual representation of downloaded web page.

In reference to dependent claim 2, 3, Netscape teaches:

A profile manager (screenshot 1) allows selection between profiles, which each have their own cache as shown by the directories the caches are stored in (screenshots 2-3). The reference provides the suggestion of a predefined access group having a single member and the multiple members, where the database is accessible to all members.

In reference to dependent claim 5, Burg teaches:

Depending on the underlying area of the displayed document, the browser application modifies the visual representation of the cursor based on the captured mouse event. See column 10, lines 1-10. It would have been obvious to one of ordinary skill in the art, having the teachings of Netscape and Burg before him at the time the invention was made, to modify the document retrieval methods taught by Netscape to include the enhanced presentation attributes appropriate to a hyperlink of Burg, because it would have provided a browser application with a proficient means for modifying the visual representation of downloaded web page based on a hyperlink area for enhancing the document being viewed by the user.

In reference to dependent claim 6, 7, 9, Burg teaches:

Depending on the underlying area of the displayed document, the browser application modifies the visual representation of the cursor based on the captured mouse event. See column 10, lines 1-10. It would have been obvious to one of ordinary skill in the art, having the teachings

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of Netscape and Burg before him at the time the invention was made, to modify the document retrieval methods taught by Netscape to include the enhanced presentation attributes appropriate to a hyperlink of Burg, because it would have provided a browser application with a proficient means for modifying the visual representation of downloaded web page based on a hyperlink area for enhancing the document being viewed by the user.

In reference to dependent claim 11, 12, Burg teaches:

Depending on the underlying area of the displayed document, the browser application modifies the visual representation of the cursor based on the captured mouse event. See column 10, lines 1-10. It would have been obvious to one of ordinary skill in the art, having the teachings of Netscape and Burg before him at the time the invention was made, to modify the document retrieval methods taught by Netscape to include the enhanced presentation attributes appropriate to a hyperlink of Burg, because it would have provided a browser application with a proficient means for modifying the visual representation of downloaded web page based on a hyperlink area for enhancing the document being viewed by the user.

In reference to claims 14-20, 22, 24, 25, the claims recite the computer program product comprising computer readable instructions used for performing the methods as claimed in claims 1-7, 9, 11, 12, and therefore are rejected under similar rationale.

Allowable Subject Matter

8. Claims 8, 10, 13, 21, 23, 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

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9. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 703-305-8043. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
February 19, 2004



**STEPHEN S. HONG
PRIMARY EXAMINER**